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COMMENTS: Transmitted herewith is an Election for:

App. No.: 10/609,263

Confirmation No.: 8103

Applicant: Eldridge

Filed: June 26, 2003

TC/A.U.: 3729

Examiner: Paul D. Kim

Docket No.: P150D1-US

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Ref. No.: 12439-0168

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. :	10/609,263	Confirmation No. 8103
Applicant :	Eldridge	-----
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Alexandria, VA 22313-1450

ELECTION

To Whom It May Concern:

Election:

In response to the Restriction of August 1, 2005, the shortened statutory period for response to which ends after September 1, 2005, Applicants hereby elect with traverse species G, which corresponds to Figure 19. Claim 40 was identified in the Restriction as corresponding to species G. Applicants note that claim 22 was identified in the Restriction as generic and should therefore be examined with claim 40, and Applicants further note that claims 33, 34, and 39 were not restricted to any particular species and therefore should also be examined with claim 40. Moreover, Applicants assert that each of claims 22-57 is generic to species G. That is, Figure 19 discloses "an exemplary robotic cell." (Specification, paragraphs [0008], [0050], [0051].) Because none of claims 22-57 excludes the use of a robotic cell such as is shown in Figure 19, each of claims 22-57 is generic to Species G. Therefore, all of claims 22-57 must be examined with elected claim 40. (See MPEP § 806.04(d).)

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Grounds For Traversing The Restriction:

Applicants respectfully traverse the Restriction on the grounds that the Examiner has not established a *prima facie* case that each of species A-O is distinct from the other species. As discussed in the MPEP, "species must be patentably distinct from each other." (MPEP § 806.04(h).) The Restriction fails even to identify characteristics of species A-N much less provided any basis for concluding that the species are distinct one from another. Absent such an explanation, the Restriction fails to set forth a *prima facie* case for restriction. The restriction requirement must accordingly be withdrawn.

Applicants further traverse the Restriction on two additional grounds. First, claims 24-26, 35, 40, 47, 52, and 53 do not recite limitations found in the species to which those claims are restricted. Second, claims 27-32, 36-38, 41-46, 48-51, and 54 do not include limitations that are mutually exclusive of other species.

The MPEP discusses the requirements for restricting a claim to a particular species as follows:

"Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that *one claim recites limitations which under the disclosure are found in a first species* but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that *claims to be restricted to different species must recite the mutually exclusive characteristics of such species.*" (MPEP § 806.04(f). (emphasis added))

There are, thus, at least two requirements for restricting a claim to a particular species: (1) the claim must recite a limitation of the species to which the claim is restricted, and (2) the claim must be exclusive to the species to which the claim is restricted, which means the claim cannot read on another species. Applicants respectfully assert that, with respect to claims 24-26, 35, 40, 47, 52, and 53, the first of the foregoing requirements is not met, and with respect to claims 27-32, 36-38, 41-46, 48-51, and 54, the second of the foregoing requirements is not met.

First, Applicants assert that claims 24-26, 35, 40, 47, 52, and 53 are not limited to the species to which they are restricted. That is, each of claims 24-26, 35, 40, 47, 52, and 53 is broader than the species to which it is restricted. (See MPEP § 806.04(f).)

Species A was identified in the Restriction as corresponding to Figure 5A. Figure 5A illustrates an exemplary technique for establishing temporary connections between an integrated circuit 502 and a module board 514. The temporary connections are established by applying a

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temporary force 512 to the integrated circuit 502. Claims 25 and 26 are not limited to establishing temporary connections between an integrated circuit and the module substrate by applying a temporary force to the integrated circuit. Claims 25 and 26 are therefore not properly restricted to species A.

Species B was identified in the Restriction as corresponding to Figure 5B. Figure 5B illustrates an exemplary technique for establishing permanent connections between an integrated circuit 502 and a module board 514 by soldering 518 the integrated circuit 502 to the module board 514. Nothing in claim 35 limits the "permanently securing" step to soldering. Claim 35 is therefore not properly restricted to species B.

Species C was identified in the Restriction as corresponding to Figure 5C, which illustrates a second exemplary technique for establishing permanent connections between an integrated circuit 502 and a module board 514. Namely, Figure 5C illustrates the use of an adhesive 520. Again, nothing in claim 35 limits the "permanently securing" step to the use of an adhesive. Claim 35 is therefore not properly restricted to species C.

Species D was identified in the Restriction as corresponding to Figure 5D, which illustrates using a clip 530 to secure an integrated circuit 502 to a module board 514. Neither claim 25 nor claim 26 is limited to the use of a clip to secure an integrated circuit to a module board 514. Claims 25 and 26 are therefore not properly restricted to species D.

Species E was identified in the Restriction as corresponding to Figures 12C and 12D, which illustrate wedging spring contacts 1210 into protrusions 1218 in vias 1220 through a module board 1214. Again, neither claim 25 nor claim 26 is limited to wedging an elongate interconnection element into a protrusion in a via through the module substrate. Claims 25 and 26 are therefore not properly restricted to species E.

Species G was identified in the Restriction as corresponding to Figure 19, which illustrates a robotic cell. Claim 40 is not limited to the use of any type of robotic cell. Therefore, claim 40 is not properly restricted to species G.

Species H was identified in the Restriction as corresponding to Figure 20A, which illustrates a prior art module 2002 with integrated circuits 2006 and 2008. Integrated circuits 2006 were rated at operating speeds of less than 700MHz, and integrated circuits 2008 were rated at operating speeds greater than 700MHz but less than 700MHz plus a guard band rating. (Specification, paragraph [0058].) Neither claim 24 nor claim 47 reads on Figure 20A. For

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example, both claims 24 and 47 depend, directly or indirectly, from claim 22, and Figure 20A does not show several elements of claim 22. For example, Figure 20A does not show "assembling an electronics module *by demountably attaching* selected ones of said integrated circuits to a module substrate." As another example, Figure 20A does not show the removing, replacing, and repeating steps of claim 22, which, as recited in claim 22, are performed "if said module fails said testing." Because claims 24 and 47 do not even read on Figure 20A, claims 24 and 47 cannot properly be restricted to species H.

Species M was identified in the Restriction as corresponding to Figure 19, which illustrates a robotic cell. Neither claim 52 nor claim 53 is limited to use of any type of robotic cell. Therefore, claims 52 and 53 are not properly restricted to species M.

Applicants' second additional grounds for traversing the Restriction is that claims 23, 27-32, 36-38, 41-51, and 54 read on more than the species to which they are restricted and thus do not meet the "mutually exclusive" requirement set forth in the MPEP and discussed above.

For example, claims 23 and 47 are restricted to Species I, which was identified in the Restriction as corresponding to Figure 24A. Claims 23 and 47 require grouping the integrated circuits in accordance with operating speeds. Nothing in claims 23 or 47, however, restricts those claims to any particular technique for establishing temporary or permanent techniques for connecting an integrated circuit to a module board. Claims 23 and 47 are therefore broad enough to be included in other species, such as, for example, species A-F. As another example, claims 23 and 47 neither require nor exclude the use of a robotic cell. Claims 23 and 47 are therefore broad enough to be included with species G and M. In fact, claims 23 and 47 should not be excluded from any other species.

Similarly, claims 27-32, 36-38, 41-46, 48-51, and 54 are broad enough to read on more than the species to which those claims are restricted. Those claims are therefore not properly restricted to the species to which they are restricted.

For all of the foregoing reasons, Applicants assert that the Restriction requirement should be withdrawn.

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If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 323-5934.

Respectfully submitted,

Date: September 1, 2005
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